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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/144,607	08/31/1998	ARTHUR W. CHESTER	10061-1	5000

7590

06/30/2003

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EXAMINER

NORTON, NADINE GEORGIANNA

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 06/30/2003

34

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/144,607

Applicant(s)

CHESTER ET AL.

Examiner

Nadine Norton

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12,14-19 and 36-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36-41 is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 6-9, 14-19, 42, 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6-12-03 has been entered.

Withdrawal of Claim Rejections Under 35 USC § 103

Applicants' amendments including the limitation defining the catalyst as an equilibrium catalyst distinguish over the previous rejections over Beck et al.(4,588,702) in view of Kugler (4,944,864); the combined teachings of Beck et al.(4,588,702), Kugler (4,944,864) and Occelli (4,615,996) and further in view of Cooper et al.(5,601,798); and Balko et al.(5,965,474) in view of Schorfheide (4,690,806) and Kugler (4,944,864).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5, 10-12, and 14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 8-10 and 12 of copending Application No. 09/221,539 in view of Beck et al.(4,588,702).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a process for reducing the sulfur content of a catalytically cracked petroleum feed fraction in the presence of a cracking catalyst and a product sulfur reduction catalyst.

A difference is noted between the present claims and the claims of Application No. 09/221,539. Claim 1 of Application No.09/221,539 includes an additional rare earth component.

The reference of Beck et al.(4,588,702) teaches that rare earth components are known promoters in catalytic cracking processes. See column 9, lines 30-35 and column 10, lines 49-55.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include an additional rare earth component in the present claims because Beck et al.(4,588,702) illustrates that rare earths are known promoters in catalytic cracking.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Double Patenting

Claims 1-3, 5 and 10-12 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 8-10 copending Application No. 09/221,540 in view of Beck et al.(4,588,702).

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Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a process for reducing the sulfur content of a catalytically cracked petroleum fraction.

A difference is noted between the present claims and the claims of 09/221,540. The present claims do not include a cerium component as defined in the claims of 09/221,540.

The reference of Beck et al.(4,588,702) teaches that rare earth components(cerium) are known promoters in catalytic cracking processes. See column 9, lines 30-35 and column 10, lines 49-55.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include an additional cerium component in the present claims because Beck et al.(4,588,702) illustrates that rare earths are known promoters in catalytic cracking.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claims 6-9, 14-19, 42 and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 36-41 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

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The prior art does not disclose or suggest reducing the sulfur content of a liquid catalytically cracked petroleum fraction involving the use of the specific catalyst defined in applicants' claims.

Response to Arguments

All previous art rejections have been removed in view of applicants "equilibrium" amendment. The double patenting rejections will remain in the case until proper terminal disclaimers are submitted.

Note: Applicants' most recent amendment added the number "42" appearing in number of claims without deleting the previous "4". As a result, the claims appear to be dependent on claim "442". It is suggested that applicants amend the claims by deleting "442" and inserting "42".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadine Norton whose telephone number is 703-305-2667. The examiner can normally be reached on Monday through Thursday from 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola be reached on 703-308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.

N.N.

June 25, 2003

NADINE G. NORTON
PRIMARY EXAMINER

Nadine